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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert Anthony Luciano JR.

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EXAMINER

YOO, JASSON H

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE DELIVERY MODE

10/27/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/788,162	<b>Applicant(s)</b> LUCIANO ET AL.	
	<b>Examiner</b> Jasson H. Yoo	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 24 July 2008.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 153-156, 158-166, 168-171 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 153-156, 158-166, 168-171 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 153-156, 158-166, 168-171 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' specification does not explicitly teach "the promotional award having no cash or game credit value". Applicants' specification does not specifically teach this negative limitation. Furthermore, Applicants' specification discloses the promotional awards are "Newprom awards". These Newprom awards are measured in a numerical value (Applicants' specification, pages 44-45, 49-53). A game play can be enhanced by using the Newprom awards. The Newprom awards are considered to have a game credit value, since the Newprom awards are measured in a numeric value that affects the game (For example, "game bonus credits" or "game enhancement credits").

Claims 153-156, 158-166, 167-171 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention. Applicants claim the limitation of "the promotional award having no cash or game credit value". However it is not clear how the promotional award is determined to be applicable if they have not game credit value. It must have some kind of game enhancement credit value to keep track on how much promotional award a player has. Game credit value is interpreted as game account information in which the information can be measured. Thus the promotional award must be in some form of game credit value (although it may not be monetary) to allow player redeem the promotional award for an enhanced game state.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 153-155, 158-165, 168-171 are rejected under 35 U.S.C. 103(a) as being unpatentable Walker (US 6,227,972) in view of Crouch (US 5,580,053).

153, 162. Walker discloses a method for enhancing game play on a gaming machine by using a promotional award. The promotional award can be purchased by the player at face value, or at a discount, given out by the casino to the player for free, or issued to a player as part of a payout (cols. 4:61-5:9). The promotional award is used as game credits configures the game play by allowing the player to play more

games or wager more credits using the promotional award. The gaming machine determines whether the promotional award is applicable on the gaming machine (determining if the satisfying conditions are met to access the balance, determining the awards are within the expiration period, determining if enough credits are available in the balance; step 710 in Fig. 7, cols. 3:47-65, 6:50-67:12, 8:1-9, 8:32-39, 10:5-61) when the gaming machine receives the promotional award from the player (player input that includes new promotional data is received in step 604 in Fig. 6A). However, Walker fails to disclose the promotional award is configured to add one or more game features to a game thereby altering the game from a base game state to an enhanced game state, wherein the game features are additional pay lines to the game, additional winning indicia for the game, a secondary game trigger, or any combination thereof. Nevertheless such modifications would have been obvious to one of ordinary skill in the art. Walker discloses the promotional award is used as game credits for at a gaming machine. There are many games that require game credits to alter the base game into an enhanced game. The enhanced game changes the rules of the base game by adding one or more game features to the base game. An example of a base game that can be altered by adding one or more game features in exchange for game credits is taught by Crouch. Crouch discloses a slot machine in which additional pay lines are added to the game for additional credits (col. 3:60-67). The base game is altered to an enhanced game where additional pay lines are in play in addition to the center pay line. Thus, by modifying Walker's gaming method of using promotional awards as game credits and Crouch's method of enhancing a base game by adding

additional pay lines to the game in exchange for game credits, base games can be altered to an enhanced game with additional game features in exchange for promotional awards. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Walker's method of using promotional awards as game credits and incorporate Crouch's method of enhancing a base game by adding one or game features in order to provide the predictable result of using promotional awards to alter a base game by adding additional game features.

Walker in view of Crouch significantly discloses the claimed invention as discussed above. However, Walker in view of Crouch fails to teach the promotional award having no cash or game credit value. However as discussed in the 112 rejections above, it is not clear nor supported in Applicants' specification how the promotional award is determined to be applicable if they have not game credit value. It must have some kind of game enhancement credit value to keep track on how much promotional award a player has.

Furthermore, Walker in view of Crouch discloses the promotional award having a cash value or game credit value to enhance a base game by adding one or more game feature. When combining Walker in view of Crouch, the function of the promotional award is used as game credits to alter the base game into an enhanced game. The function of the cash value or the credit value itself is used to keep track on how much promotional award a player has. This is used to determine whether the promotional award provided and whether the promotional award is applicable to the game (similarly to Applicants' invention). Additionally, it would have been obvious to one of ordinary

skilled in the art to limit the promotional credits for only altering game play when modifying Walker's promotional award to incorporate Crouch's method of altering a base game into an enhanced game from a base game. Limiting the promotional awards to be spent on game features instead of free games (games paid by promotional awards) will help increase profit for the gaming operator.

Walker in view of Crouch further discloses the following:

154, 164. The method of claim 153, wherein the new promotional award includes time restriction data having a predetermined, fixed expiration date for the new promotional award (Walker, cols. 2:55-3:2, 5:10-6:35).

155, 165. The method of claim 153, wherein the new promotional award includes location restriction data that restricts use of the new promotional award to a predetermined location or a predetermined set of locations (The promotional award or prepaid card is restricted to be used at the casino in which the prepaid card was received by the player, Walker, cols. 2:15-53, 3:3-46, 5:15-20).

158-159, 168-169. Walker in view of Crouch discloses the claimed invention as discussed above but fails to teach the following: reconfiguring the at least one game further comprises providing additional pay lines to the game, adding additional winning indicia to the game, triggering a secondary game, or any combination thereof; providing a new pay table for the game in response to the new promotional award; and applying a

multiplier to any winning outcomes of the game. These game features are commonly known game features are that specific to the base game. For example: additional pay lines and secondary games are well known to be provided for slot machines when additional game credits are wagered. New pay tables and award multipliers are also well known to be provided for extra game credits. The specific type of game features use on various base games is a design choice. When using Walker in view of Crouch's method of using promotional awards to alter a base game by adding additional game features on various base games, would require the game features to change according to the base game. For example, incorporating Walker's invention of using promotional award as gaming credits on a slot machine that has three pay lines, wherein each pay line normally require game credits, would allow the player to use the promotional award to activate the pay line. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made and modify Walker in view of Crouch's method of enhancing a base game by adding one or game features and incorporate various game enhancements in order to provide the predictable result of enhancing a base according to the nature of the base game.

160, 170. The method of claim 153, further comprising issuing a new promotional award to the player during a gaming session (issued to a player as part of a payout on a slot machine, Walker, cols. 4:61-5:9).



161, 171. The method of claim 153, further comprising issuing a new promotional award to the player at the conclusion of a gaming session (issued to a player when the payout is awarded, Walker, cols. 4:61-5:9).

163. The method of claim 162, wherein receiving player input further comprises:  
accepting player identification (Walker, col. 7:22-37); and  
retrieving new promotional data that is associated with the player identification (Walker, col. 7:38-57).

Claims 156 and 166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,227,972) in view of Crouch (US 5,580,053) as applied to claims 153 and 162 above, and further in view of Walker'765 (US 6,364,765).

156, 166. Walker'972 in view of Crouch discloses the method of or enhancing game play on a gaming machine using promotional awards as discussed above. Walker'972 in view of Crouch teaches the promotional awards are awarded to the players (Walker'972, col. 4:61-5:9) and to attract new customers and increase customer loyalty (Walker'972, col. 1:12-29). The promotional awards are also used to stimulate business in a casino during off-peak periods (Walker'972, col. 2:46-48). The casino can increase the customer loyalty with promotional awards and regulate the usage of promotional awards during off-peak periods by including restrictions such as an expiration time for the promotional awards, a time frame in which the players can use the promotional

awards, or a minimum spending amount before the awards can be in effect (Walker'972, Figs. 5A-5B, col. 3:13-65). Furthermore, Walker'972 in view of Crouch discloses slot machines that can receive player's information and determine if the player is within limits set by the restriction fields and use the promotional awards (Walker'972, step 616 Fig. 6A, col. 7:13-37, 7:59-8:9, 8:65-9:16). However, Walker'972 in view of Crouch does not specifically teach the restriction of the new promotional award to a particular game, a set of related games, a family of games, or a predetermined subset of games. In an analogous art to casino restrictions with awards Walker'765 discloses a method of playing a game where the casino restricts the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games. Walker'765 discloses a secondary game played to play in specific slot machines or types of slot machines (Walker'765, cols. 7:3-815), in order for the casino operators to effectively utilize the valuable floor space of a casino. By encouraging player to move to higher profit machines or encouraging an idle player to play any machine, casinos can achieve a higher profit per machine. Directing slot players to particular machines also benefits players by enhancing or expanding their gaming experiences (Walker'765, col. 3:32-43). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker'972 in view of Crouch's gaming method and incorporate a location restriction, restricting the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games, in order to utilize the floor space of a casino and encourage players to move to higher profit machines.

### ***Response to Arguments***

Applicants' arguments filed 7/24/08 have been fully considered but they are not persuasive.

Applicants traverse the 112 first paragraph rejection arguing that the limitation of "the promotional award having no cash or game credit value" is positively recited in the specification as an alternative element. Applicants indicates page 14, lines 14-15 of the specification disclose this negative limitation with the disclosure of "unlike game credits which are used for playing the game 100, may be directed redeemed for prizes or awards on prize station 112." "The prizes are not generally redeemable via award credits earned by the player from playing gaming device." This is not a positively recitation of the negative limitation of "the promotional award having no cash or game credit value." Applicants' invention is not directed to a method of using promotional awards having no cash or game credit value. Applicants' invention is directed to using promotional awards. The promotional awards can be in many forms. Furthermore, the quotation cited to support Applicants' arguments appears to be taken out of context. The Specification discloses "**Award credits**, unlike game credits which are used for playing the game 100..." (Applicants' specification page 14, lines 14-15). The specification discloses that these "credits" are "**award credits**" and not the **promotional awards** that are used in the claimed invention (Applicants *claimed invention* is described in pages 44-53 not pages 14-18). Award credits have game credit value. They are game awards in the form credits that can be measured (has a value). Hence, award

credits have game credit value. Similarly page 18 of Applicants' specification is also directed to award credits.

Regarding claims 153-156, 158-166, 167-171, rejecting under 35 USC 112 first paragraph under new matter, Applicants arguments are similar to the arguments for the 112 first paragraph rejection under new matter. See response to arguments above. Furthermore, to clarify the rejection, "game credit value" is interpreted as game account information in which the information can be measured. Thus the promotional award must be in some form of game credit value (although it may not be monetary) to allow player redeem the promotional award for an enhanced game state.

Arguments for claims 153-155, 158-165, 168-171 rejected under 35 US 103 over Walker in view of Crouch are based on the 112 rejections above. See response to arguments above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JHY